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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte J.J. GARCIA-LUNA-ACEVAS and
BRADLEY R. SMITH

Appeal 2007-4079
Application 09/845,088
Technology Center 2100

Decided: March 31, 2008

Before HOWARD B. BLANKENSHIP, JAY P. LUCAS, and
ST. JOHN COURTENAY III, *Administrative Patent Judges*.

COURTENAY, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134(a) from the
Examiner's rejection of claims 1-11. We have jurisdiction under 35 U.S.C.
§ 6(b). We AFFIRM.

THE INVENTION

The disclosed invention relates generally to the discovery of information objects, and servers storing information objects distributed over computer networks. More particularly, the present invention is directed to controlling access to content carried in a caching architecture (Spec. 3).

Independent claim 1 is illustrative of the invention:

1. A method, comprising:

directing a client's request for an information object to an information object repository without regard as to whether the information object is actually stored at the information object repository; and

determining, according to information included in a uniform resource locator (URL) whether the client is authorized to receive the information object.

THE REFERENCES

The Examiner relies upon the following references as evidence in support of the rejections:

McCanne	US 6,415,323 B1	Jul. 2, 2002
Shanumgam	US 6,708,187 B1	Mar. 16, 2004
McCanne	US 6,785,704 B1	Aug. 31, 2004

THE REJECTIONS

1. Claims 1-11 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over McCanne '323, in view of Shanumgam.

PRINCIPLES OF LAW

In rejecting claims under 35 U.S.C. § 103, “[w]hat matters is the objective reach of the claim. If the claim extends to what is obvious, it is invalid under § 103.” *KSR Int'l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727, 1742 (2007). To be nonobvious, an improvement must be “more than the predictable use of prior art elements according to their established functions.” *Id.* at 1740.

Appellants have the burden on appeal to the Board to demonstrate error in the Examiner’s position. *See In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006) (“On appeal to the Board, an applicant can overcome a rejection [under § 103] by showing insufficient evidence of *prima facie* obviousness or by rebutting the *prima facie* case with evidence of secondary indicia of nonobviousness.”) (quoting *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998)). Therefore, we look to Appellants’ Briefs to show error in the proffered *prima facie* case.

ANALYSIS Claims 1-11

We consider the Examiner’s rejection of claims 1-11 as being unpatentable over McCanne ‘323, in view of Shanumgam. Since Appellants’ arguments have treated these claims as a single group which stand or fall together, we select independent claim 1 as the representative claim for this rejection. *See* 37 C.F.R. § 41.37(c)(1)(vii).

Combinability under 35 U.S.C. § 103

Appellants contend that the combination of McCanne '323 and Shanumgam is based on impermissible hindsight, and no adequate motivation or other reasons for combining these teachings has been presented (App. Br. 11, § B).

In view of the Supreme Court's recent opinion in *KSR Int'l Co. v. Teleflex Inc.*, our analysis here does not turn upon whether the Examiner has provided an adequate teaching, suggestion, or motivation to combine the references. Instead, we view the question before us to be whether sufficient differences exists between the prior art and Appellants' claims to render the claims nonobvious. In *KSR*, the Supreme Court reaffirmed that "when a patent 'simply arranges old elements with each performing the same function it had been known to perform' and yields no more than one would expect from such an arrangement, the combination is obvious." *KSR*, 127 S. Ct. at 1740 (quoting *Sakraida v. AgPro, Inc.*, 425 U.S. 273, 282 (1976)).

This reasoning is applicable here. The Examiner contends that it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine McCanne '323 with Shanumgam because it would have provided the trusted computing based concept, discretionary access control, labels, mandatory access controls, object reuse, audit, identification and authentication, trusted path, and security testing (App. Br. 12, ll. 6-8).

After considering the evidence before us, it is our view that McCanne '323 provides sufficient evidence that combining policy enforcement with a redirection system is an arrangement of old elements. In addition,

Appellants proffer an expected result that would arguably result from the combination of McCanne '323 and Shanumgam (Reply Br. 13, ll. 7-12).

Appellants contend that McCanne '323 teaches away from any such combination with Shanumgam (Reply Br. 13). Appellants then restate the results of such a combination as previously presented in the Appeal Brief (Reply Br. 13, ll. 7-12). However, Appellants have not provided a basis or rationale for the assertion that the cited references teach away from each other (App. Br. 12, ll. 8-11). It is our view that an artisan possessing ordinary skill and creativity would have been capable of combining familiar elements such as the policy management system taught by Shanumgam with the redirection system taught by McCanne '323.

Our reviewing court has reaffirmed that “[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *Leapfrog Enter., Inc., v. Fisher-Price, Inc.*, 485 F.3d 1157, 1161 (Fed. Cir. 2007) (quoting *KSR*, 127 S. Ct. at 1739). Here we note that Appellants have not rebutted the Examiner’s legal conclusion of obviousness by showing that the claimed combination of familiar elements produces any new function. Moreover, Appellants have not provided any factual evidence of secondary considerations, such as unexpected or unpredictable results, commercial success, or long felt but unmet need. Accordingly, we find Appellants’ arguments unpersuasive that the cited references have been improperly combined by the Examiner.

Elements under 35 U.S.C. § 103

Appellants contend that the combination of McCanne '323 and Shanumgam, fails to teach the use of information included in a uniform

resource locator (URL) to determine whether a client is authorized to receive requested content. More specifically, Appellants contend that the combination of McCanne ‘323 and Shanumgam would only yield an authentication policy and a redirection scheme in which user domain information would be used to authenticate clients as part of a content request. URL information would be used to determine which content server to retrieve the requested content from (App. Br. 10, § VII. A.). Appellants further assert that the result of the combination is different than the recited features of information included in a uniform resource locator (URL) to determine whether a client is authorized to receive the requested content (*Id.*).

The Examiner disagrees. The Examiner notes that McCanne ‘323 teaches that the service infrastructure provides fine-grained control, monitoring, and customization of the client where the client/user is someone who pays for goods or services (Ans. 9, ¶1). The Examiner, as finder of fact, has determined that McCanne ‘323 *inherently* teaches that the client is authorized to access connections (Ans. 9, ll. 7-11). The Examiner further notes that McCanne ‘323 also teaches embedding additional information in the URL to identify the particular location or other attributes for the content in question (*Id.*, ll. 11-13). The Examiner relies on Shanumgam for its teaching of a single policy enforcer to authenticate the user and to protect the network from malicious users by blocking URLs (Ans. 8, ll. 16-19).

After considering the evidence before us, we find that Shanumgam’s teaching of a user domain at least suggests the use of a URL that is used to authenticate clients as part of a context request (col. 5, ll. 46-52). In light of the above, we agree with the Examiner’s findings that the combination of

McCanne '323 and Shanumgam reasonably teaches and/or suggests "determining, according to information included in a uniform resource locator (URL) whether the client is authorized to receive the information object," as claimed (claim 1).

Further, although McCanne '323 and Shanumgam teach authentication, the Examiner has made a finding that the "authorization" of the client is inherently taught by McCanne '323 (Ans. 9, ll. 7-11).

We note that "[i]n relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic *necessarily* flows from the teachings of the applied prior art." *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original). "[A]fter the PTO establishes a *prima facie* case of anticipation based on inherency, the burden shifts to appellant to 'prove that the subject matter shown to be in the prior art does not possess the characteristic relied on.'" *In re King*, 801 F.2d 1324, 1327 (Fed. Cir. 1986) (quoting *In re Swinehart*, 439 F.2d 210, 212-13 (CCPA 1971)). *See also* MPEP §§ 2112 (IV.), (V.).

This reasoning is applicable here. We find the Examiner has provided a rationale in the Answer that reasonably supports the finding of inherency. We see no response in the Brief or Reply Brief that specifically addresses the Examiner's finding that the authenticated client *must be* authorized to access connections (see Ans. 9, ll. 7-11). Therefore, we find Appellants have not met the burden of proving that the subject matter shown to be in the prior art does not possess the characteristic relied on by the Examiner.

For at least the aforementioned reasons, we conclude Appellants have not shown that the Examiner erred in establishing *prima facie* obviousness in

rejecting representative claim 1. Therefore, we sustain the Examiner's rejection of representative claim 1 as being unpatentable over McCanne '323, in view of Shanumgam. Pursuant to our authority under 37 C.F.R. § 41.37(c)(1)(vii), we have decided the appeal with respect to the remaining claims in this group on the basis of the representative claim alone. Thus, we sustain the Examiner's rejection of claims 2-11 as being unpatentable over McCanne '323, in view of Shanumgam.

CONCLUSION OF LAW

Based on the findings of facts and analysis above, we conclude that Appellants have not shown the Examiner erred in rejecting claims 1-11 under 35 U.S.C. § 103(a) for obviousness.

DECISION

The decision of the Examiner rejecting claims 1-11 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

cc

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